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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

SAFAIPOUR, HOUSHANG

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2625

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02/25/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

<b>Application No.</b> 10/826,008	<b>Applicant(s)</b> BRAKE ET AL.	
<b>Examiner</b> HOUSHANG SAFAIPOUR	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 02 November 2008.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-51 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 2-4, 8-12, 15, 17-23, 27-29, 31-36, 39-45 and 48-50 is/are rejected.
- 7)  Claim(s) 5-7, 24-26, 37 and 38 is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
- Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response to Amendment***

Applicant's amendment filed on 11/02/2008 has been entered.

***Response to Arguments***

Regarding claims 2, 18 and 35, the only argument presented by the applicant is that "...there is no disclosure of any sort of visual [**not claimed**] feedback outlining a darkened perimeter of the area to scan." Examiner respectfully disagrees. Paragraph [0021] of Wu discloses the scanning area can be easily set without a pre-scan since the original document is viewable to the user. Methods to measure distance can be adapted to measure the boundaries and then the data can be converted to control signals to operate the scanning mechanism. For example, the methods used to detect the position of a touch on a touch screen can be adapted. Take the example of a resistive overlay, two linear overlay structures are created along each slidebar for the two slide positions. The overlay structure consists of conductive layers (considered as liquid crystal panel) separated by a line of tiny insulating dots. Pressure from an elastic contact from the slide pushes the two layers together, creating an electrical contact. The electrical contact will give a specific voltage related to the **location of the contact**. The voltage signal is then converted into digital data for controlling the scanning mechanism. In fact, **a sensitive screen** can be used for the back transparent platen 34 and two points at diagonal position can define the scanning area (darkened perimeter). Therefore with this explanation, the rejection of claims 2, 18 and 35 are maintained and this discussion is applicable to the new limitation added to claims 2, 18 and 35. Applicant argues that claims 3-9, 19-26 and 36-41 are believed to be allowable because of their dependency on claims 2, 18 and 35. This argument is

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moot based on the discussion given above for rejection of independent claims 2, 18 and 35.

Applicant's arguments regarding claims 5-7, 24-26 and 37-38 are persuasive and the claims are indicated as allowable if written in an independent form (please see "Allowable Subject Matter" below). Applicant argues that claims 10-12, 27-29 and 42-45 are believed to be allowable because of their dependency on claims 2, 18 and 35. This argument is moot based on the discussion given above for rejection of independent claims 2, 18 and 35. Applicant argues that claims 15, 17, 31-34 and 48-50 are believed to be allowable because of their dependency on claims 2, 18 and 35. This argument is moot based on the discussion given above for rejection of independent claims 2, 18 and 35. Arguments regarding liquid crystal elements have been responded to in the discussion given above.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2, 18, 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu (U.S.20050094216).

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Regarding claim 2, Wu discloses a scanner comprising a substantially transparent platen on a first side of the scanner (see "transparent platen 34" in paragraph [0017], also see 34 in Figure 2), a substantially transparent window on a second side of the scanner opposite the first side (see "transparent platen 32" in paragraph [0017], also see 32 in Fig.2), a touch screen affixed proximate to the substantially transparent window wherein touch location information is generated in response to at least one touch of the touch screen and wherein the touch location information is used to select an area to scan (see "the scanning area can easily be set...as shown in Fig. 3" in paragraph [0021], and also see "a sensitive screen can be used for the back transparent platen 34 and two points at diagonal position can define the scanning area" in paragraph [0021], also see "touch screen" in paragraph [0021]). For newly added limitation, please refer to the discussion above under "Response to the Arguments".

Regarding claim 18, Wu discloses a system comprising a scanner comprising a substantially transparent platen on a first side of the scanner (see "transparent platen 34" in paragraph [0017], also see 34 in Figure 2), a substantially transparent window on a second side of the scanner opposite the first side (see "transparent platen 32" in paragraph [0017], also see 32 in Figure 2), a touch screen affixed proximate to the substantially transparent window wherein touch location information is generated in response to at least one touch of the touch screen and wherein the touch location information is used by the system to select an area to scan (see "the scanning area can easily be set...as shown in Fig. 3" in paragraph [0021], and also see "a sensitive screen can be used for the back transparent platen 34 and two points at diagonal position can define the scanning area" in paragraph [0021], also see "touchscreen" in paragraph [0021]) near the platen (see where the scanner meets the book in Figure 2), and a computer

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wherein the computer and the scanner are in communication (see "scanner is used...with a computer through a...interface" in paragraph [0016]). For newly added limitation, please refer to the discussion above under "Response to the Arguments".

Regarding claim 35, see rejection of claim 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-9, 19-26, 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S.20050094216).

Regarding claim 3, Wu does not disclose a figure traced on the touch screen by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on what the user wants to scan. Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 3.

Regarding claim 4, Wu does not disclose that the area to scan is rectangular.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on what the user wants to scan.

Wu is analogous art because it is from the art of imaging devices. Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s)

Regarding claims 5-7, Wu does not disclose that touches occurring during a predetermined interval of ten seconds, immediately preceding initiation of a scan, are considered in the selection of the area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on when the user wants to input the area to scan.

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 5-7.

Regarding claims 8, Wu does not disclose that touches occurring after a reset operation, are considered in the selection of the area to scan.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on when the user wants to input the area to scan.

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 8.

Regarding claim 9, Wu does not disclose scanner control logic for interpreting the touch location information and selecting the area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because Wu teaches that "the scanning operations can performed...the related software for scanning can be stored and run in a CPU and related memory provided on the portable flatbed scanner" (see paragraph [0023] ).

Wu is analogous art because it is from the art of imaging devices. Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s)

Regarding claims 19-20, Wu does not disclose that the communication is cable or wireless.



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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because whether the communication is cable or wireless, it would still achieve the same purpose of establishing a connection between the scanner and computer.

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 19-20.

Regarding claim 21, Wu does not disclose that the touch location information is sent to the computer which sends to the scanner configuration information derived from the touch location information, the configuration information indicating the area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because Wu teaches that it is possible for scanning parameters to be set through a computer (see "scanning parameters ...can be set up through a computer" in paragraph [0018]).

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 21.

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Regarding claim 22, see rejection of claim 3.

Regarding claim 23, see rejection of claim 4.

Regarding claim 24, see rejection of claim 5.

Regarding claim 25, see rejection of claim 6.

Regarding claim 26, see rejection of claim 7.

Regarding claim 36, see rejection of claims 3 & 4.

Regarding claim 37, see rejection of claims 5 & 6.

Regarding claim 38, see rejection of claim 7.

Regarding claim 39, see rejection of claim 8.

Regarding claim 40, Wu does not disclose being performed entirely in the scanner.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because Wu teaches that it is possible to have "related software for scanning...stored and run in a CPU and related memory provided on the portable flatbed scanner" (see paragraph [0023] ).

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 40.

Regarding claim 41, Wu does not disclose being partly performed in the scanner and partly performed in a computer that is in communication with the scanner.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because Wu teaches that it is possible to have "a flatbed scanner is used in association with a computer through a computer interface...The software in the computer can set up the scanning parameters and control the scanning operation" (see paragraph [0016]).

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 41.

Claims 10-12, 27-29, 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S.20050094216) in view of the admitted prior art.

Regarding claim 10, Wu does not disclose a preview scan that results in a preview digital image, and analyzing the preview digital image using automated region detection, and selecting as the area to scan an automatically detected region that encompasses a location.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features in the device of Wu.

The suggestion / motivation for doing so would have been because the admitted prior art teaches that these features are nothing new in the art (see "typical desktop scanner...performs a preview scan...The preview scan data...has been analyzed ...perform automated region classification and selection based on analysis of the results of a preview scan, so that a user need

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only designate...which of the suggested regions displayed on the computer screen represents the area to be captured" in paragraphs [002]-[003] of applicant's specification).

Wu and the admitted prior art are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with the admitted prior art to obtain the invention specified in claim(s) 10.

Regarding claims 11-12, Wu does not disclose that the preview scan occurs before or after the touch of the touch screen.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on when the user wants to perform a preview scan.

Wu and the admitted prior art are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with the admitted prior art to obtain the invention specified in claim(s) 11-12.

Regarding claim 27, Wu also does not disclose transmitting the preview digital image to the computer, analyzing in the computer, software, and sending configuration information from the computer to the scanner.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features in the device of Wu.

The suggestion / motivation for doing so would have been because the admitted prior art teaches that these features are nothing new in the art (see "typical desktop scanner...performs a preview scan...The preview scan may be initiated by selecting a function in software operating on the computer...perform automated region classification and selection based on analysis of the results of a preview scan, so that a user need only designate...which of the suggested regions displayed on the computer screen represents the area to be captured" in paragraphs [002]-[003] of applicant's specification, also see "interact...the computer and the scanner" in paragraph [004]).

Wu and the admitted prior art are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with the admitted prior art to obtain the invention specified in claim(s) 27.

Regarding claim 28, see rejection of claim 11.

Regarding claim 29, see rejection of claim 12.

Regarding claim 42, see rejection of claim 10.

Regarding claim 43, see rejection of claim 12.

Regarding claim 44, see rejection of claim 11.

Regarding claim 45, see rejection of claim 27.

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Claims 15, 17, 31-34, 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S.20050094216) in view of Chiba et al (U.S.7292378).

Regarding claim 15, Wu does not disclose that the liquid crystal elements nearest to locations where the touchscreen is touched are switched to the light-blocking state.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because Chiba teaches a liquid crystal panel and a touch screen being used together on a scanner, for user input related purposes (see "image reader 1300 according to...FIG.31" in lines 4-5 in col.61, also see "a touch screen 1314 is adhered to the LCD 1313 and is utilized to input commands required for various types of operations...For inputting a command using the touch screen 1314, a pen 1322 shown in FIG.34 may be used...The pen 1322 can be held at the holding section 1322a, a user presses the touch screen 1314 with the tip section 1322b while visually checking an operating input screen displayed on the LCD 1313 shown in FIG. 31" in lines 50-65 in column 64).

Wu and Chiba are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with Chiba to obtain the invention specified in claim(s) 15.

Regarding claim 17, Wu does not disclose that the liquid crystal elements switched to the light-blocking state outline a rectangular perimeter of the area to scan.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because Chiba teaches a liquid crystal panel and a touch screen being used together on a scanner, for user input related purposes (see "image reader 1300 according to...FIG.31" in lines 4-5 in col.61, also see "a touch screen 1314 is adhered to the LCD 1313 and is utilized to input commands required for various types of operations...For inputting a command using the touch screen 1314, a pen 1322 shown in FIG.34 may be used...The pen 1322 can be held at the holding section 1322a, a user presses the touch screen 1314 with the tip section 1322b while visually checking an operating input screen displayed on the LCD 1313 shown in FIG. 31" in lines 50-65 in column 64).

Wu and Chiba are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with Chiba to obtain the invention specified in claim(s) 17.

Regarding claims 31-34 and 48-50 please refer to the discussion above under "Response to the Arguments".

#### ***Allowable Subject Matter***

Claims 5-7, 24-26, 37 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipour whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Houshang Safaipour/  
Primary Examiner, Art Unit 2625